REMARKS

Reconsideration of the present application is respectfully requested in view of the following remarks. Prior to entry of this response, claims 1-27 were pending in this application, of which claims 1, 10, and 19 are independent. In the Office Action mailed November 14, 2006, claims 6, 15, and 24 were rejected under 35 U.S.C. § 112, first paragraph and claims 1-27 were rejected under 35 U.S.C. §103(a). Following this response, claims 1-27 remain pending in this application. Applicants hereby address the Examiner's rejections.

I. Rejection of the Claims Under 35 U.S.C. §112, First Paragraph

The Examiner rejected claims 6, 15, and 24 under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. These claims have been amended herein to more clearly recite the limitations contained therein, although Applicants respectfully submit that the amendments do not change the scope of claims 6, 15, and 24 as previously presented. Support for these amendments is found in the specification at least at paragraphs 44-45. Applicants respectfully assert that claims 6, 15, and 24, as amended, overcome the Examiner's rejection under §112, first paragraph and request that it be withdrawn.

II. Rejection of the Claims Under 35 U.S.C. §112, Second Paragraph

The Examiner also rejected claims 6, 15, and 24 under 35 U.S.C. §112, second paragraph as failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. As described above in Section I, Applicants have amended claims 6, 15, and 24 herein, and respectfully assert that the amended claims

overcome the Examiner's rejection under §112, second paragraph. Accordingly, Applicants request that this rejection be withdrawn.

III. Rejection of the Claims Under 35 U.S.C. § 103(a)

The Examiner rejected independent claims 1, 10, and 19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,836,744 ("Asphahani"). To establish a *prima facie* case of obviousness, the cited reference(s) must teach or suggest each limitation of the claim. Because Asphahani does not teach each limitation of claims 1, 10, or 19, the Examiner has not established a *prima facie* case of obviousness with respect to any of those claims.

Claim 1 recites, among other things, "determining a cushioning requirement based on the plurality of pressure readings." In the Office Action, the Examiner points to the abstract of Asphahani as teaching this limitation. But nowhere in its abstract, nor in the remainder of the specification, does Asphahani teach or suggest determining a cushioning requirement based on a plurality of pressure readings. Asphahani does teach taking a plurality of pressure readings, but this feature is also recited elsewhere in Applicants' claim 1 and does not constitute "determining a cushioning requirement." Asphahani does not teach or suggest using these pressure readings to generate a cushioning requirement appropriate to the user. Furthermore, claim 1 recites "receiving a plurality of pressure readings wherein the pressure readings comprise a position value, a pressure value and a time." While Asphahani teaches measuring the pressure experienced at a number of areas of a user's foot, it does not teach associating a time value with each pressure reading. Because Asphahani does not teach or suggest every limitation of claim 1, a *prima facie* case of obviousness has not been established, and

Applicants respectfully request that the rejection of claim 1 be withdrawn. Because claims 2-9 depend from claim 1 and include each of its limitations, Applicants respectfully request that the rejection of those claims be withdrawn, as well.

Like claim 1, claim 10 recites "receiving a plurality of pressure readings wherein the pressure readings comprise a position value, a pressure value and a time" and "determining a cushioning requirement based on the plurality of pressure readings." As described above, Asphahani does not teach or suggest either of these recitations, and Applicants request that the rejection of claim 10 be withdrawn. Because claims 11-18 depend from claim 10 and include each of its limitations, Applicants also request that the rejection of those claims be withdrawn. Similarly, claim 19 recites a system comprising a memory and a microprocessor coupled to the memory and programmed to, among other things, "receive a plurality of pressure readings where the pressure readings comprise a position value, a pressure value and a time" and to "determine a cushioning requirement based on the plurality of pressure readings." Because Asphahani does not teach or suggest a system with these capabilities, Applicants request that the rejection of claim 19 be withdrawn. Because claims 20-27 depend from claim 19 and include each of its limitations, Applicants request that the rejection of those claims be withdrawn, as well.

In further regard to claims 5, 14, and 23, the Examiner contends that Asphahani teaches determining a recommended shoe based on the level of cushioning and the degree of pronation, pointing to column 3, line 3 of Asphahani. However, this passage merely notes that the pressure and gait analyses performed by the disclosed system "can assist footwear consumers in proper shoe selection," thus leaving it to a user to

determine an appropriate shoe based on the raw data provided by the system. The system of Asphahani does not determine a recommended shoe based on a determined cushioning requirement and a pronation requirement, as recited in claims 5, 14, and 23. In addition to the reasons discussed above with regard to the independent claims, this further shows that a *prima facie* case of obviousness has not been established with respect to claims 5, 14, and 23.

The Examiner also asserted that claims 6, 15, and 24 were obvious over Asphahani in view of U.S. Patent No. 5,813,142 ("Demon"), U.S. Patent No. 6,122,846 ("Gray"), and U.S. Patent No. 5,564,202 ("Hoppenstein"). First, Applicants observe that none of these references teaches the following recitation of claims 6, 15, and 24:

> if the average pressure of the heel of the foot is greater than a high threshold value, setting the cushioning requirement as high; and if the average pressure of the heel of the foot is not greater than the high threshold value and the average pressure of the forefoot is less than a low threshold value, setting the cushioning requirement as low; and if the average pressure of the heel of the foot is not greater than the high threshold value and the average pressure of the forefoot is not less than the low threshold value, setting the cushioning requirement as medium.

In particular, none of the references teaches setting the cushioning requirement as low if the average pressure of the heel of the foot is not greater than a high threshold value and the pressure of the forefoot is less than a low threshold value. Nor do any of the references teach setting the cushioning requirement as medium if the average heel pressure is lower than a high threshold value and the average forefoot pressure is not less than a low threshold value. Because none of these references teaches or suggests adjusting a cushioning requirement based on pressures experienced in these particular

areas of a foot, a *prima facie* case of obviousness has not been established with respect to claims 6, 15, or 24.

Furthermore, the Examiner points to various passages of these disparate references and asserts that it would somehow have been obvious to modify the disclosure of these references, none of which teaches the specific elements quoted above, to satisfy the recitations of claims 6, 15, and 24. However, in order to properly combine references, there must be some suggestion or motivation in the art to combine these references. Here, there is no motivation to combine the references in the manner suggested by the Examiner. For example, Asphahani discloses a "shoe sole with an adjustable support pattern." Gray, meanwhile, discloses a force-monitoring shoe for use in rehabilitation of an injured lower extremity. While Gray discloses alerting the wearer if forces fall below a threshold level, the purpose is not to change the cushioning provided by the shoe. Instead, the purpose of Gray's invention is to alert the wearer that the wearer is not providing the proper weight on the injured extremity—thereby assisting the user in rehabilitating the injured extremity. Because the purpose of Gray has nothing to do with determining the proper level of cushioning, there is no motivation to combine Asphahani and Gray in the manner suggested by the Examiner. Accordingly, Applicants respectfully assert that the Examiner's rejection of claims 6, 15, and 24 over Asphahani in view of Gray, Demon, and Hoppenstein is improper and request that it be withdrawn.

In further regard to claims 7, 16, and 25, the Examiner asserts that Asphahani discloses "determining a cushion requirement and a speed of the foot," and that it would have been obvious to analyze the speed of the forefoot and adjust the cushioning

requirement based on the speed of the forefoot. In support of this assertion, the Examiner cites column 3, lines 11-12 of Asphahani. However, as this very passage makes clear, Asphahani teaches measuring angular velocity. In contrast, claims 7, 16, and 25 recite "determining a speed of the forefoot." As Applicants' specification states, "the speed of the foot at various points is the rate of change of the position of the foot from a first point on the bottom of the foot to a second point on the bottom of the foot." Asphahani at ¶ 41. Thus, Asphahani's disclosure of measuring angular velocity does not teach or suggest "determining a speed of the foot" as recited by the claims. Furthermore, as discussed above, Asphahani does not teach or suggest determining a cushioning requirement, much less changing a cushioning requirement based on the measured speed of the forefoot. Because Asphahani does not teach or suggest the limitations recited in claims 7, 16, and 25, Applicants respectfully request that the Examiner withdraw the rejection of those claims.

IV. Conclusion

In view of the foregoing remarks and amendments, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims. The claims may include other elements not addressed herein that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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